

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks.

Claim 20 has been amended editorially.

Non-elected claims 25, 26, and 27 have been cancelled without prejudice.

Claims 1-5 have been rejected under 35 U.S.C. 102 (e) as being anticipated by Yoshino et al. (US Patent Application Publication No. 2004/0058258). Applicants respectfully traverse this rejection.

The priority date of the present invention, December 10, 2002, predates the effective prior art date of the US filing of Yoshino, April 9, 2003. A verified translation of the present priority application is filed herewith. Therefore, the rejection is moot. Applicants do not concede the correctness of this rejection.

Claims 1-3 and 6 have been rejected under 35 U.S.C. 102 (e) as being anticipated by Sugiura et al. (US Patent Application Publication No. 2003/0152857). Applicants respectfully traverse this rejection.

The rejection relies on Example B-9 of Sugiura. In this example, Sugiura discloses use of an external additive silica with dimethylsilicone oil and zinc stearate (see para. 0543) but does not disclose that dimethylsilicone oil and zinc stearate are adhered to the silica powder. The method disclosed in the reference is mixing of dimethylsilicone oil and zinc stearate with silica while adding heat-treated hydrophobic silica thereto (see para. 0543, Example B-9). In contrast, the present invention requires that polysiloxane, e.g., dimethylsilicone oil, and fatty acid (or its derivative), e.g., zinc stearate, are adhered to a surface of an inorganic micropowder, e.g., silica (see claim 1).

In addition, Sugiura's purpose for including the inorganic powder as additives is to ensure tensile fracture strength between toner particles during compressive toner transfer (see para. 0046). In this invention of claim 1, the additives provide high

partability between a photosensitive member and a toner adhering to the photosensitive member and suppress partial transfer defects and back-transfer (see page 14, lines 7-13 of the specification).

Therefore, the present invention is distinguished from Sugiura. Accordingly, the rejection should be withdrawn.

Claims 12-14, 17, 23, and 24 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857) in view of Kobayashi et al. (US Patent Application Publication No. 2003/0091923). Applicants respectfully traverse this rejection.

Claim 12 includes the features of claim 1 discussed above. Claim 12 is allowable for the same reasons as discussed for claim 1 above. Kobayashi is cited for a carrier coating layer and does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

Claims 4 and 5 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857) in view of "Technical Information TI 1222, Special Hydrophobic AEROSIL® (SHA) for Toners," Nippon Aerosil, p. 5. Applicants respectfully traverse this rejection.

These claims are allowable over Sugiura for the same reasons as discussed for claim 1 above. TI 1222 does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

Claims 15 and 16 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857) in view of Kobayashi et al. (US Patent Application Publication No. 2003/0091923); in view of "Technical Information TI 1222, Special Hydrophobic AEROSIL® (SHA) for Toners," Nippon Aerosil, p. 5. Applicants respectfully traverse this rejection.

These claims are allowable over Sugiura and Kobayashi for the reasons as discussed for claim 12 above. TI 1222 does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

Claim 10 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857) in view of Tyagi et al. (US Patent No. 6156473). Applicants respectfully traverse this rejection.

The claim is allowable over Sugiura for the same reasons as discussed for claim 1 above. Tyagi does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

Claim 21 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857); in view of Kobayashi et al. (US Patent Application Publication No. 2003/0091923); further in view of Tyagi et al. (US Patent No. 6156473). Applicants respectfully traverse this rejection.

The claim is allowable over Sugiura for the same reasons as discussed for claim 12 above. Kobayashi and/or Tyagi does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

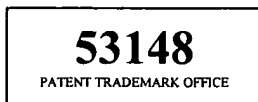
Claims 7-11 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857) in view of Yuasa et al. (US Patent Application Publication No. 2002/086229). Applicants respectfully traverse this rejection.

The claim is allowable over Sugiura for the same reasons as discussed for claim 1 above. Yuasa does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

Claims 18-22 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (US Patent Application Publication No. 2003/0152857) in view of Kobayashi et al. (US Patent Application Publication No. 2003/0091923); in view of Yuasa et al. (US Patent Application Publication No. 2002/0086229). Applicants respectfully traverse this rejection.

These claims are allowable over Sugiura for the same reasons as discussed for claim 12 above. Kobayashi and/or Yuasa does not remedy such deficiencies of Sugiura. Applicants are not conceding the correctness of the rejection.

In view of the above, Applicants request reconsideration of the application in the form of a Notice of Allowance.



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Respectfully submitted,

HAMRE, SCHUMANN, MUELLER &
LARSON, P.C.
P.O. Box 2902
Minneapolis, MN 55402-0902
(612) 455-3800

By: _____

Douglas P. Mueller
Reg. No. 30,300
DPM/my/lis